

### **REMARKS**

Claims 1-3, 5-7, 12-18 and 21-24 are pending in the present application. Applicant respectfully requests reconsideration of the claims based on the following remarks.

Claims 1-3, 12-15, 17, 21 and 22 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,190,170. Applicant has submitted herewith a terminal disclaimer that obviates the foregoing rejection of claims 1-3, 12-15, 17, 21 and 22.

Claims 1-2, 6-7, 12-15, 17-18, 21-22 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dietz et al. U.S. Patent No. 6,642,717 in view of Wang et al. U.S. Publication No. 2004/0225213.

Independent claim 1 recites in part: "a volume percentage of the plurality of conductive particles is 0.1% or less of a volume of the conductive compound such that a current flowing through the conductive compound is limited to less than 10 microamps to reduce electrostatic discharges in the glue."

Dietz et al. is directed to a magnetic resonance apparatus. Wang is directed to a magnetic resonance imaging coated assembly. Applicant initially notes that neither reference recognizes the problem of electrostatic discharges in glue within a gradient assembly, nor offer any solution for reducing electrostatic discharges. In particular, Dietz et al. does not provide any teaching of: "a volume percentage of the plurality of conductive particles is 0.1% or less of a volume of the conductive compound such that a current flowing through the conductive compound is limited to less than 10 microamps to reduce electrostatic discharges in the glue", as recited in claim 1.

Applicant further notes that the Examiner's statement that the limit "less than 10 microamps is not given any patentable weight over Dietz et al. '717 because both Dietz et al. '717 and the present application are concerned with limiting current", is clearly improper. See Office Action,

page 4, lines 103. In particular, applicant submits that claim 1 includes specific limitations that cannot be ignored by the Examiner in determining the patentability of the claim. Applicant further notes that the Examiner has clearly misconstrued Dietz et al., since Dietz et al. is not concerned with limiting current as suggested by the Examiner. In contrast, Dietz et al. utilizes a thermally conductive damping structure with thermally conductive particles to absorb oscillations in a gradient coil system. See Dietz et al., column 2, lines 6-10.

Further, Wang et al. does not provide any teaching of: "a volume percentage of the plurality of conductive particles is 0.1% or less of a volume of the conductive compound such that a current flowing through the conductive compound is limited to less than 10 microamps to reduce electrostatic discharges in the glue", as recited in claim 1. In contrast, Wang et al. merely discusses a "flexible member having ferromagnetic particles embedded therein a concentration of about 0.001% to about 10% by *weight* of the material..." See Wang et al., paragraph [0010]. In particular, applicant notes that the term "volume" in claim 1 is not equivalent to "weight" of Wang et al., as suggested by the Examiner.

Accordingly, because the combination of Dietz et al. and Wang et al. does not teach each and every limitation of claim 1, applicant submits that claim 1, and claims 2, 6, 7 which depend from claim 1, are allowable over these references.

Independent claim 12 recites in part: "the potting compound layer having a plurality of conductive particles configured to limit a current flowing through the potting compound layer to less than a predetermined current value to reduce electrostatic discharges in the potting compound layer, the plurality of conductive particles being at least one of silver particles and gold particles."

Dietz et al. does not provide any teaching of utilizing silver and gold conductive particles in a potting compound layer as recited in claim 12. Further, Wang et al. does not teach the foregoing limitations of claim 12. In contrast, Wang et al. merely discloses that a sheath 2002 can be formed from conductive materials such as silver and gold. See Wang et al., paragraph [0206]. However, the sheath 2002 is clearly not a potting compound layer as recited in claim 12.

Accordingly, because the combination of Dietz et al. and Wang et al. does not teach each and every limitation of claim 12, applicant submits that claim 12 is allowable over these references.

Independent claim 13 recites in part: "a volume percentage of the plurality of conductive particles is 0.1% or less of a volume of the conductive compound such that a current flowing through the conductive compound is limited to less than 10 microamps to reduce electrostatic discharges in the glue."

Dietz et al., however, does not provide any teaching of: "a volume percentage of the plurality of conductive particles is 0.1% or less of a volume of the conductive compound such that a current flowing through the conductive compound is limited to less than 10 microamps to reduce electrostatic discharges in the glue", as recited in claim 13. Further, Wang et al. does not teach the foregoing limitations of claim 13.

Accordingly, because the combination of Dietz et al. and Wang et al. does not teach each and every limitation of claim 13, applicant submits that claim 13, and claims 14, 15, 17 and 18 which depend from claim 13, are allowable over these references.

Independent claim 21 recites in part: "a volume percentage of the plurality of conductive particles being within a predetermined volume percentage range of the conductive compound such that a current flowing through the conductive compound to less than 10 microamps to reduce electrostatic discharges in the glue."

Dietz et al., however, does not provide any teaching of: "a volume percentage of the plurality of conductive particles being within a predetermined volume percentage range of the conductive compound such that a current flowing through the conductive compound to less than 10 microamps to reduce electrostatic discharges in the glue", as recited in claim 21. Further, Wang et al. does not teach the foregoing limitations of claim 21.

Accordingly, because the combination of Dietz et al. and Wang et al. does not teach each and every limitation of claim 21, applicant submits that claim 21, and claims 22 and 24 that depend from claim 21, are allowable over these references.

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Dietz et al. U.S. Patent No. 6,642,717 in view of Wang et al. U.S. Publication No. 2004/0225213 as applied to claim 1 above, and further in view of Doty U.S. Patent No. 5,530,355.

Claim 3 depends from claim 1 and therefore incorporates all of the limitations of claim 1 therein. As discussed above, the combination of Dietz et al. and Wang et al. does not provide any teaching of: "a volume percentage of the plurality of conductive particles is 0.1% or less of a volume of the conductive compound such that a current flowing through the conductive compound is limited to less than 10 microamps to reduce electrostatic discharges in the glue", as recited in claim 1. Further, the addition of Doty does not result in a combination that teaches the foregoing limitations of claim 1.

Accordingly, because the combination of Dietz et al., Wang et al., and Doty does not teach each and every limitation of claim 1, and claim 3 that depends from claim 1, applicant submits that claim 3 is allowable over these references.

Claims 5 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dietz et al. U.S. Patent No. 6,642,717 in view of Wang et al. U.S. Publication No. 2004/0225213 as applied to claims 2 and 22 above, and further in view of Lehne et al. U.S. Patent No. 5,235,283.

Claim 5 depends from claim 1 and therefore incorporates all of the limitations of claim 1 therein. As discussed above, the combination of Dietz et al. and Wang et al. does not teach: "a volume percentage of the plurality of conductive particles is 0.1% or less of a volume of the conductive compound such that a current flowing through the conductive compound is limited to less than 10 microamps to reduce electrostatic discharges in the glue", as recited in claim 1. Further, the addition of Lehne et al. does not result in a combination that teaches the foregoing limitations of claim 1.

Accordingly, because the combination of Dietz et al., Wang et al., and Lehne et al. does not teach each and every limitation of claim 1, and claim 5 which depends from claim 1, applicant submits that claim 5 is allowable over these references.

Claim 23 depends from claim 21 and therefore incorporates all of the limitations of claim 21 therein. Claim 21 recites in part: "a volume percentage of the plurality of conductive particles being within a predetermined volume percentage range of the conductive compound such that a current flowing through the conductive compound is limited to less than 10 microamps to reduce electrostatic discharges in the glue." As discussed above, the combination of Dietz et al. and Wang et al. does not teach the foregoing limitations of claim 21. Further, the addition of Lehne et al. does not result in a combination that teaches the foregoing limitations of claim 21.

Accordingly, because the combination of Dietz et al., Wang et al., and Lehne et al., does not teach each and every limitation of claim 21, and claim 23 which depends from claim 21, applicant submits that claim 23 is allowable over these references.

In view of the remarks discussed above, it is respectfully submitted that the present application is in condition for allowance. Such action is most earnestly solicited. If for any reason the Examiner feels that consultation with applicant's attorney would be helpful in the advancement of prosecution, the Examiner is invited to call the telephone number below for an interview.

If there are any charges due with respect to this Response or otherwise, please charge them to Deposit Account No. 06-1130, maintained by the applicant's attorney.

Respectfully submitted,

By: /JohnFBuckert/  
John F. Buckert  
Reg. No. 44,572

Date: January 8, 2009  
Telephone: (248) 524-2300  
Fax: (248) 524-2700